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V.S.

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/855,905 05/14/97 YAMANAKA

M 443-17

EXAMINER

IM62/0520

ROCCO S BARRESE
DILWORTH AND BARRESE
333 EARLE O'VINGTON BLVD
UNIONDALE NY 11553

KEUER, K

ART UNIT

PAPER NUMBER

1773

DATE MAILED:

05/20/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/855,905

Applicant(s)
Yamanaka, Koyama, And Ueda

Examiner
Kevin Krueer

Group Art Unit
1773



☒ Responsive to communication(s) filed on Mar 15, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-26 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-26 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☒ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 7, 8

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 23 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims refer to "ultra fine cracks" on line 1, but the specification fails to define what constitutes an ultra fine crack. Therefore, it is impossible to determine the scope of the claims.

3. Claims 23 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims contain the process limitation that the antistatic agent is incorporated into the matrix of the polypropylene via kneading. However, it is unclear from the claim when the kneading takes place during the processing of the film. From the claim language, it appears as if Applicant is claiming that the antistatic agent is incorporated into the polypropylene after the polypropylene has been oriented.

4. Claims 23 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims state that the anti-static agent appears "easily" on the surface of the

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oriented polypropylene. However, it is unclear what is meant by "easily" and, therefore, it is impossible to determine the scope of the claim.

5. Claims 25 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims contain the limitation that the paper possesses "good" surface resistivity, and ink adhesion. However, "good" is a relative term with no clear or concise definition. Thus, the term "good" is indefinite in that it does not clearly define the scope of the claims.

6. Claims 25 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims contain the limitation that the paper possesses "suitability" for paper feeding/discharge. However, "suitability" is a relative term with no clear or concise definition.

Thus, the term "suitability" is indefinite in that it does not clearly define the scope of the claims.

7. Claims 21 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims contain the limitation that the paper possesses "excellent" printability, ink adhesion, and permanent antistatic properties. However, "excellent" is a relative term with no clear or concise definition. Furthermore, Applicant does not provide a working definition in the specification of what "excellent" entails. Thus, the term "excellent" is indefinite in that it does not clearly define the scope of the claims.

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Claim Rejections - 35 USC § 103

8. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takashi et al. (Pat. No. 4,318,950) in view of European Patent 0 613 919 A1 (aka Ueda) for reasons of record.

Response to Arguments

9. Applicant's arguments filed March 15, 1999 have been fully considered but they are not persuasive. Applicant argues, and the examiner admitted in the first office action, that Takashi does not teach the claimed polypropylene composition. However, the examiner would like to state for the record that the outstanding claim rejection did not depend upon Takashi to teach the claimed polypropylene composition.

Applicant further argues that the combination of Takashi and Ueda is dependent upon hindsight. The examiner respectfully disagrees with Applicant's assessment of the references. Applicant argues two reasons why the examiner's rejection is believed to be based on hindsight.

First, Applicant argues that Ueda does not disclose a composition having the claimed composition in a stretched film. While it is true that Ueda never taught an embodiment in which a film comprising the claimed composition is stretched, it is noted that Takashi is the primary reference and is relied upon for its teachings of how to process an antistatic polypropylene composition into a synthetic paper. Ueda was relied upon merely to show a polypropylene composition having improved anti-static properties. Takashi was relied upon to teach that inorganic filler may be added to an antistatic polypropylene composition, and then that composition may be uniaxially or biaxially stretched and utilized as the ink receptive layer of a

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synthetic paper laminate. Takashi teaches, and it is well known in the art, that by stretching a polypropylene film, the film's printability remarkably improves. The examiner argued that polypropylene films possessing antistatic properties are desirable in the paper industry. Such antistatic films are especially desirable in the field of offset printing, wherein static buildup can lead to blurring and smudging of the ink.

Secondly, Applicant argues that neither references teaches the composition may be utilized in the fields of offset printing or flexography. However, the examiner takes the position that intended use of the prior art compositions/laminates need not be the same for the claimed laminate structure.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin R. Kruer whose telephone number is (703) 305-0025. The examiner can normally be reached on Monday-Friday from 7:00 a.m. to 4:00 p.m.



Kevin R. Kruer
Patent Examiner



Paul Thibodeau
Supervisory Patent Examiner
Technology Center 1700